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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 09/844,747
Filing Date: April 25, 2001
Appellant(s): FINCH, WILLIAM R.

Jaison C. John
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 05, 2006 appealing from the Office action mailed December 12, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interference**

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(4) Status of Amendments**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of the invention contained in the brief is correct.

**(6) Grounds of rejection to be reviewed on appeal**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

| | | |
|---|---|---|
| 5,412,783 | Skokan | 05-1995 |
| 6,618,376 | Rumer | 09-2003 |

**(9) Grounds of Rejection**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 25-27 and 29 are rejected under 35 U.S.C. §102(b) as being anticipated by Skokan [U.S. Patent No. 5,412,783].

Skokan anticipated (e.g., see Figs. 1-2) the invention substantially as claimed. Taking claims 1 and 25 as exemplary claims, the reference disclosed a communication system comprising:

a) a bus (e.g., see a bus 10 of Figs. 1 and 2) including at least one data line (11) and control lines (13) (e.g. see col. 3, lines 28-46);

b) a first device (e.g. one of items 3 to 9 of Fig. 1, col. 3) coupled to the bus;

c) a second device (e.g. one of items 3 to 9 of Fig. 1, col. 3) coupled to the bus, the data line being coupled between the first and second device (e.g. see Figs. 1-2, col. 3); and

d) a handshaking unit (e.g., see col. 3 (line 35) to col. 5 (line 62)) coupled (it is inherent teaching of Figs. 3-5) to the control lines (13) of the bus (10) and being adapted to determine if the first and second devices are capable of completing a data transfer and enable the first and second devices to facilitate the data transfer.

As to claims 2-3 and 26-27, Skokan further anticipated the feature of data transfer based on the assertion of the first and second data available line (e.g. see data

lines 11 are active and the Assertion of the ACK handshake signal, col. 3 (line 35) to col. 5 (line 62)).

As to claims 5 and 29, Skokan further anticipated the control line (13) include a clock line (inherent in any computer bus) and the handshaking unit is adapted to provide a clock signal to the first and second devices on the clock line (e.g., see col. 3 (line 35) to col. 5 (line 62)).

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 6-24, 28 and 30-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Skokan [U.S. Patent No. 5,412,783] as applied to claims 1-3, 5, 25-27 and 29 above and in further view of Rumer [U.S. Patent No. 6,618,376].

. As to claims 4 and 28, Skodan did not explicitly mention that his first and second devices (e.g. any two of network devices 3-9 of Fig. 1) include UTOPIA interfaces. Such feature of UTOPIA interfaces is clearly taught by Rumer (e.g. see UTOPIA 30a, 30b of devices 32a and 32b of Fig. 1).

As to claims 6-10 and 30-34, Skodan did not explicitly mention that his first and second devices (e.g. any two of network devices 3-9 of Fig. 1) comprises a first pair of devices and the communication system further comprises a plurality of pairs of devices. And each pair of the network devices are adapted to communicated data arranged in an ATM cell and data transfer. Moreover, Skodan did not explicitly mention about polling those devices. However Rumer clearly disclosed: a) pairing two devices (e.g. see the

pair of devices 32a and 32b of Fig. 1); b) ATM cells (e.g. see the abstract, col. 4 (line 61) to col. 5 (line 14)); and c) polling the devices (e.g. see col. 5, lines 26-30).

As suggested by Skodan (e.g. see col. 2, lines 43-46), his system disclosed the use of the entire link bandwidth across the interconnection medium (e.g. a communication interface such as a switch) in a very effective way and Rumer also disclosed a communication interface (e.g., ATM UTOPIA switch, the title, col. 2 (lines 47-67)) for establishing the communication across shared communication bus. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Rumer's communication interface into Skodan's interconnection medium because by incorporating Rumer's teaching of a communication interface, for establishing the communication across shared communication bus, into Skokan's interconnection medium would enhance Skodan's interconnection medium to have additional desirable feature of establishing the communication across communication bus with the use of entire link bandwidth.

As to claims 11-12 and 35, such feature of an interface device (e.g., a modem) having a plurality of ports is a well known feature and it is easily available in the market.

Claims 13-24 are similar in scope as of claims 1-11 and 25-35, and therefore claims 13-24 are rejected for the same reasons set forth above for claims 1-11 and 25-35.

**(10) Response to Argument**

In the remarks, appellant argued in substance that:

a) Skokan is directed to providing a handshaking signal that is encoded to facilitate transfer of the handshaking signal from a first network segment to a second network segment. The handshaking signals discloses by Skokan are not coupled to the control lines of a bus.

**In reply,** first of all Figures 3-5 of Skokan disclose the teaching the handshake signal for a bus including the teaching of a data signal and a control signal. And, it is obvious that those signals are coupled to the bus. Therefore, the handshaking signals discloses by Skokan are obviously coupled to the control lines of a bus in order for those signals are working together in order to control the data transfer on the bus. Moreover, the independents claims 1, 13 and 25 mention nothing about a first network segment and a second network segment. Those claims mention only a first device and a second device which can be any thing (emphasis added by the examiner). Secondly, Skokan clearly discloses a handshaking signals that inherently coupled to the control bus (see col. 3 (line 35) to col. 5 (line 62), the teaching of Figs. 3-5). Further, Skokan mention the well known teaching of the prior art of Fig. 3 and Fig. 4. These two figures 3 and 4 show handshake signals for a bus. More specifically Skokan discloses, in Fig. 5, col. 3 (lines 35-62), the teaching of a handshake signal coupled to the control lines of bus (e.g., see the handshake signal 111 and sampled and encoded control signal "C" from a control line 13).

b) Skokan is directed to an asynchronous handshake signal being encoded to facilitate data with a transfer of the handshaking signal from the first network segment to a second network segment. Specially, one reason that Skokan does not anticipate or make obvious elements of claimed invention is that the timing signals of Skokan, which may carry a handshaking signal is entirely different from the control signal disclosed by Skokan. Therefore, the Examiner erred in equating the separate **timing and control signals** and interpreting them to satisfy the elements associated with the utilization of the bus. **Skokan could not possibly satisfy this element since not only does Skokan lack the disclosure of a handshaking unit**, Skokan affirmatively asserts that any handshaking signal is not present on a control signal.

**In reply**, first of all the present invention of handshaking unit is nothing more than just a rectangle box 50 of Fig. 1 and a rectangle box 50 of Fig. 2 having Rx control 52 and Tx Control 54. As mentioned in the rejection of claim 1, Skokan clearly discloses a

handshaking unit (e.g., see the handshake teaching in Figs. 3-5) being adapted to determine and facilitate the data transfer. And there is nothing to do with Skokan timing signals and control signals. Thus, the appellant's argument is not co-extensive with the claimed language (e.g., see claims 1, 13 and 25 of the present invention).

c) The bus disclosed in Skokan contains separate control lines and does not carry handshaking signals which is in contrast to claims of the present invention. Skokan simply do not disclose a handshaking unit that is coupled to the control line of a bus and being adapted to determine if a first device and a second device that are coupled to the bus are capable of completing a data transfer. **In fact, Figures 1 and 2 simply do not disclose a handshaking unit whatsoever.** Skokan d**iscloses that the handshaking signals are not coupled to the control lines since the handshaking signals are part of the timing signal, i.e., the control lines are on a separate line and the handshaking signal is yet another separate line**.

**In reply**, first of all Examiner would like to remind the appellant that there are 7 figures in Skokan, not just two figures 1 and 2. And, the appellant wrote 6 pages of arguments that Skokan did not teach such and such. However, the key point of the arguments are nothing more than the arguments a), b) and c) in summary above. By mentioning only Figures 1 and 2 have nothing to do with handshaking unit is nothing more than the appellant clearly and deliberately try to ignore the other teaching of figures 3-7 of Skokan. Once again, the appellant must read the whole reference and the appellant can not simply pick and choose only the portion of the reference and say that the reference does not teach this and that. Skokan clearly teaches such simple handshaking unit (e.g., a handshake signal as broadly called by Skokan) and this simple handshaking unit as claimed is so well known in the art at the time the invention was made (e.g., see the prior art teaching of Fig. 3 and 4 of Skokan and Fig. 5). And, Examiner does not see any significant or specials about this simple proclaimed handshaking unit of the present invention. Moreover, the appellant is reminded that the appellant's bus 20 (e.g., see Figs. 1-2 of the present invention) is nothing special or an extraordinary bus because this bus 20 contains only with well known elements of a data line, an address line, a control and a

signal line. Moreover, the appellant's handshaking unit 50 of figures 1 and 2 is simply a rectangle box with the label handshaking unit and a rectangle box or a magic box with Rx control label and Tx control label.

e) On pages 11-15 of the brief, in summary, the appellant argued that:

i) The Examiner is unable to establish a prima facie case of obviousness based upon Skokan and Rumer.

ii) The combination of Skokan and Rumer do not suggest, teach, or make obvious all of the elements of claims 4, 6-24, 28 and 30-35.

iii) There is insufficient motivation in Skokan and Rumer to prompt one skilled in the art to combine the prior art disclosure to make obvious all of the elements of claims 4, 6-24, 28 and 30-35.

iv) Examiner has not provided sufficient evidence or arguments to illustrate that sufficient motivation is found within the cited prior art that would directed one of ordinary skilled in the art to modify the prior art to make obvious all of the elements of claims 4, 6-24, 28 and 30-35.

**In reply** to e) above, Examiner respectfully disagrees. In re Rinehart, 189 USPQ 143 (CCPA 1976) clearly stated that a prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness. In re Palmer, 172 USPQ 126 (CCPA 1971) further states the burden falls to the appellant to rebut it with objective evidence of non-obviousness, and mere argument does not overcome the prima facie case of obviousness. As mentioned in the rejection, Examiner clearly established a prima facie case of obviousness based on Skokan and Rumer because Examiner presented to the appellant what is the teaching of Skokan; what is not;

what is the teaching of Rumer; and the reason to combine the teaching of these two references. Moreover, the appellant is reminded that the obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). In this case, as suggested by Skodan (e.g. see col. 2, lines 43-46), his system disclosed the use of entire link bandwidth across the interconnection medium (e.g. a communication interface such as a switch) in a very effective way and Rumer also disclosed a communication interface (e.g., ATM UTOPIA switch, the title, col. 2 (lines 47-67)) for establishing the communication across shared communication bus. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Rumer's communication interface into Skodan's interconnection medium because by incorporating Rumer's teaching would enhance Skodan's interconnection medium to have an additional desirable feature of establishing the communication across communication bus with the use of entire link bandwidth.

(11) **Related Proceedings Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this Examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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